

## **REMARKS**

### **Status of the Claims.**

Claims 1-15 are pending with entry of this amendment, no claims being canceled and no claims being added herein. Claims 9 and 12 are amended herein to correct nomenclature and/or grammatical errors.

### **Claim objections:**

#### **Claim 1.**

Claims 1 was objected to because the amended formula of claim 1 is allegedly not indicated in the specification. The Examiner noted that the amended formula of claim 1 is supported by the description of formula V and by the peptide sequences of Tables 3 and 4 and requested that applicants amend Formula V to be consistent with the formula of claim 1.

To expedite the prosecution, Applicants have amended formula V accordingly thereby obviating this objection.

Please note, however, that Applicants reserve the right to file subsequent applications claiming the amended out subject matter and the amendment should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

#### **Claim 9.**

Claim 9 was objected to because of the recitation of "9-(2,5 (or 2,6)-dicarboxyphenyl)-3,6-bis(dimethylamino)xanthylumhalide". The Examiner alleged that the first two fluorophores contain either 2,5-dicarboxyphenyl isomer or 2,6-dicarboxyphenyl isomer which should be cited separately. Similar comments were made regarding the last two fluorophores.

Claim 9 is amended herein per the Examiner's recommendation thereby obviating this objection.

#### **Claim 12.**

Claim 12 was objected to because of misspelling and/or an allegedly incorrect formula. Claim 12 is amended herein thereby obviating the Examiner's objections.

**New Matter.**

The Examiner objected to the amendments filed March 17, 2003 and April 12, 2004 under 35 U.S. C. §132 because they allegedly introduce new matter into the disclosure. In particular the Examiner alleged that the specification does not indicate C7 as an X or Y group in the formula of fluorogenic peptides. Applicants traverse.

The Application as originally filed clearly identifies C7 as a member of the groups defined by X and Y. For Example, claim 1 as originally filed states:

1. A fluorogenic composition for the detection of the activity of a protease, said composition having the formula:  
... X is selected from the group consisting of Gly,  $\beta$ Ala,  $\gamma$ Abu, Gly-Gly, Ahx, C7, ... (see claim 1 at page 65, line 35)  
... Y is selected from the group consisting of Gly,  $\beta$ Ala,  $\gamma$ Abu, Gly-Gly, Ahx, C7, ... (see claim 1 at page 66, lines 3-4) ...

In addition, C7 is expressly defined as "8-aminocaprylic acid" in Table 1 on page 7.

Table 4, at page 26, also clearly identifies X as including C7.

**35 U.S.C. §112, First Paragraph.**

Claims 1-15 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. In particular, the Examiner alleged that the specification does not indicate that X or Y is C7. The Examiner further alleged that C7 is not defined and hence there is no structural description of C7. Applicants traverse.

The Examiner is reminded that the specification is regarded as including the claims as originally filed. As explained above, claim 1, as originally filed clearly identifies C7 as being included within X and Y (see, claim 1 at page 65, line 35, and at page 66, lines 3-4).

Moreover, contrary to the Examiner's assertion the specification expressly defines C7 as "8-aminocaprylic acid" (see, Table 1 on page 7). The specification thus provides adequate and complete structural description of C7. Accordingly, contrary to the Examiner's assertion, Applicants have clearly met the description requirement and the rejection of claims 1-15 on these grounds should be withdrawn.

**35 U.S.C. §112, Second Paragraph.**

Claims 1-15 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite because of the recitation of "C7" as an X or Y group. The Examiner alleged that ". . . it is not clear what structure the C7 has since neither the specification nor the claim[s] define the term." Applicants traverse.

As indicated above, Table 1, on page 7 expressly defines "C7" as "8-aminocaprylic acid". The term "C7" is thus clearly and fully defined. Consequently, claims 1-15 are not indefinite and the rejection under 35 U.S.C. §112, second paragraph, on these grounds should be withdrawn.

In view of the foregoing, Applicants believes all claims now pending in this application are in condition for allowance, but for the filing of a Terminal Disclaimer. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Should the Examiner seek to maintain the rejections, Applicants request a telephone interview with the Examiner and the Examiner's supervisor.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 337-7871.

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Respectfully submitted,



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